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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/679,054	10/03/2000	Albrecht Dorschner	Beiersdorf 656-KGB	4744

7590 03/24/2004  
NORRIS, MCLAUGHLIN & MARCUS, P.A.  
220 EAST 42ND STREET  
30TH FLOOR  
NEW YORK, NY 10017

EXAMINER

LAMM, MARINA

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/679,054

**Applicant(s)**

DORSCHNER ET AL.

**Examiner**

Marina Lamm

**Art Unit**

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 5,7-11 and 16-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5,7-11 and 16-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Acknowledgment is made of the amendment filed 11/20/03. Claims pending are 5, 7-11 and 16-19. Claims 12 and 13 have been cancelled. Claim 5 has been amended.

#### ***Double Patenting***

1. The provisional obviousness-type double patenting rejection of Claims 5, 7-11 and 16-19 as being unpatentable over claims 5-18 of copending Application No. 10/365,847 is maintained for the reasons of the record.

#### ***Claim Rejections - 35 USC § 102***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. The rejection of Claims 5 and 7-11 under 35 U.S.C. 102(b) as being anticipated by Thomas et al. (US 5,610,130) is maintained for the reasons of the record.

#### ***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. The rejection of Claims 16 and 17 under 35 U.S.C. 103(a) as being unpatentable over Thomas et al. in view of Moore et al. (US 6,063,746) is maintained for the reasons of the record.
6. The rejection of Claims 18 and 19 under 35 U.S.C. 103(a) as being unpatentable over Thomas et al. in view of Klier et al. (US 4,127,672) is maintained for the reasons of the record.

*Response to Arguments*

7. Applicant's arguments filed 11/20/03 have been fully considered but they are not persuasive.

8. With respect to the Thomas et al. reference, Applicants argue that Thomas et al. fails to teach every element of the applicants' claims invention because stearic acid is taught in the reference as an optional ingredient and the reference "never teaches the degree of specificity required by the applicants' claims". See pp. 4-5 of the Remarks. In response, it is noted that the compositions containing fatty acid is the Thomas' preferred embodiment because "the addition of fatty acid or fatty acid soap provides an improvement in the rinsability of the composition" and foam suppression. See col. 13, lines 7-22. In addition, compositions C and D of Example 1 contain 0.5% of a fatty acid. See col. 14. Stearic acid is exemplified as one of the acceptable fatty acid. See col. 13, line 20. Alternatively, Applicants argue that the reference's composition "have a surfactant mixture of (i)-(iii), (C) *and stearic acid* (at least five essential components plus the insect repellant) vs. applicants claimed invention (only two essential components plus the insect repellant)". (emphasis in original). See p. 5 of the Remarks. In response, it is noted that the claim language "consisting essentially of" does not exclude the presence of additional components unless the Applicants provide an evidence that the presence of those additional components "would materially affect the basic and novel characteristics of the claimed invention." See MPEP 2111.03 citing *In re Hertz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976). Further, Applicants argue that there is no indication that Thomas et al. is enabling for applicants' claimed invention. See pp. 5-6 of the Remarks. In particular, Applicants argue that there no indication that any of the Thomas'

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required elements could be eliminated without adversely affecting their ability to form stable o/w microemulsion. In response, it is noted that the instantly claimed compositions are not limited to the recited components and may include additional elements as discussed above. With respect to the 103 rejection of Claims 16 and 17, the Applicants argue that there is no suggestion to combine the references. In response, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the claimed emulsifiers are well known in the emulsion art and are conventionally used for the same art-recognized purpose as the emulsifiers of Thomas et al., i.e. for the formation and stabilization of oil-in-water emulsions. Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to use cetareth-12 and/or cetareth-20 of Moore et al. for emulsions of Thomas et al. with a reasonable expectation of obtaining a stable oil-in-water microemulsion having the same or similar properties as set forth in the Thomas et al. reference. The selection of a known material based on its suitability for its intended use is obvious absent a clear showing of unexpected results attributable to the applicant's specific selection.

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (571) 272-0618. The examiner can normally be reached on Mondays, Wednesdays and Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached at (571) 272-0602.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the

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Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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3/21/04

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SUPERVISORY PATENT EXAMINER  
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